

REMARKS

The Office Action of March 18, 2008 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection are traversed and overcome. Upon entry of this Amendment, claims 1-25 remain in the application. Reconsideration of the claims is respectfully requested.

Claims 1-25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that Applicants' specification as filed fails to provide a basis for the recitation, "and wherein the amount of water soluble polyurethane present in the ink composition is fully dissolved" and the recitation, "only one resin, the only one resin being" in claim 1. The Examiner concludes that these recitations constitute new matter.

In order to expedite prosecution, claim 1 has been amended to remove the recitation, "and wherein the amount of water soluble polyurethane present in the ink composition is fully dissolved", thereby rendering moot the 35 U.S.C. § 112, first paragraph, rejection to this recitation in the claim.

Regarding the recitation, "only one resin, the only one resin being" in claim 1, Applicants submit that this is fully supported by Applicants' specification as filed. For example, page 2, line 28 of Applicants' specification as filed states, "... from 0.5 to 3% of **one** or more water-soluble polyurethanes...." Also, page 3, lines 13-16 of Applicants' specification as filed states, "***The ink compositions include from 0.1 to 5%, preferably from 0.5 to 3% water-soluble polyurethane.***" In certain embodiments the ink compositions ***may include a mixture of two or more*** different polyurethanes, e.g., 2, 3, 4, or 5 different polyurethanes." (emphasis added). Thus, in one embodiment, only one polyurethane is used, and in other embodiments, two or more polyurethanes are used. It is submitted that claim 1 is directed to the ***embodiment*** that includes only one polyurethane resin. As such, it is submitted that the recitation, "only one resin, the only one resin being" in claim 1 is fully supported by Applicants' specification as filed and, thus, is ***not*** new matter. Accordingly, it is submitted that the 35 U.S.C. § 112, first

paragraph, rejection to claims 1-25 with respect to this recitation is erroneously based, and withdrawal of the same is respectfully requested.

Claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts that the terminology, “fully dissolved” recited in claim 1 is unclear. To reiterate from above, this recitation has been removed from claim 1, thereby rendering moot the 35 U.S.C. § 112, second paragraph, rejection to the claims.

Claims 1-4, 6-10, 17-23, and 25 stand rejected under 35 U.S.C. § 102(a) as being anticipated by WO 03/097753 (the equivalent of which is Waki, et al. (U.S. Patent Publication No. 2004/0242726)). The Examiner alleges that Waki teaches all of the elements of independent claim 1. The Examiner notes that Waki teaches two resins, however the Examiner alleges that both of the resins in Waki are water-soluble polyurethanes. The Examiner concludes that a mixture of polyurethane molecules that are water soluble meets the limitation in claim 1 that the ink composition includes “only one resin.”

In response thereto, Applicants respectfully disagree with the Examiner that Waki teaches that both resins are water soluble polyurethanes. Paragraph [0013] of Waki states that a pigment dispersion for an ink jet contains 1) a water soluble resin, and 2) a resin having a urethane bond and/or an amide bond. Applicants *strongly* disagree that the water soluble resin in Waki may be polyurethane. Paragraphs [0033] – [0054] of Waki provide several examples of suitable water soluble resins that may be used in the pigment dispersion. **None** of these examples include polyurethane or a resin having a urethane bond. The resins including the urethane bond are *separate and distinct* resins, examples of which are provided in paragraphs [0056] – [0057] of Waki. Because Waki teaches 1) the existence of two resins in the pigment dispersion, and 2) where one resin may include a urethane bond and the other resin does not, Applicants submit that Waki does **not** teach “**only one resin**, the only one resin being a **water-soluble polyurethane**,” as recited in claim 1 (emphasis added).

As such, it is submitted that Applicants’ invention as defined in independent claim 1, and in those claims depending ultimately therefrom, is not anticipated, taught or

rendered obvious by Waki, either alone or in combination, and patentably defines over the art of record.

Claims 5 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki. For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 5 and 24 depend. Applicants further submit that Waki fails to render obvious claims 5 and 24, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki, either alone or in combination, and patentably defines over the art of record.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Iu, et al. (U.S. Patent No. 6,102,998). For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 11 and 12 depend, and that Iu fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Iu fails to render obvious claims 11 and 12, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Iu, either alone or in combination, and patentably defines over the art of record.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Ma, et al. (U.S. Patent No. 5,648,405). For the reasons stated above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 13 and 14 depend, and that Ma fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Ma fails to render obvious claims 13 and 14, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Ma, either alone or in combination, and patentably defines over the art of record.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Waki in view of Elwakil (U.S. Patent No. 5,833,743). For the reasons stated

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above, Applicants submit that Waki fails to anticipate or render obvious independent claim 1, from which claims 15 and 16 depend, and that Elwakil fails to supply the deficiencies thereof. Applicants further submit that the combination of Waki and Elwakil fails to render obvious claims 15 and 16, at least because of their dependency from claim 1. As such, it is submitted that Applicants' invention as defined in these claims is not anticipated, taught, or rendered obvious by Waki and Elwakil, either alone or in combination, and patentably defines over the art of record.

In summary, claims 1-25 remain in the application. It is submitted that, through this Amendment, Applicants' invention as set forth in these claims is now in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

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